



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1409
Alexandria, Virginia 22304-0409
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/900,008 | 07/09/2001 | Yoshiyuki Shino | 35 C15536 | 4382 |
| 5514 | 7990 | 01/23/2004 | EXAMINER | |
| FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112 | | | DICUS, TAMRA | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1774 | |

DATE MAILED: 01/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

| | |
|-------------------------------|------------------------------|
| Application No. 09/000,008 | Applicant(s) SHINO ET AL. |
| Examiner Tamm L. Dicus | Art Unit 1774 |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 December 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 2 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
 ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
 2. ☒ The proposed amendment(s) will not be entered because:
 (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ they raise the issue of new matter (see Note below);
 (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet

3. ☒ Applicant's reply has overcome the following rejection(s): cancelled claim 17 only under 102(b) to Nakajima.
 4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet
 6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
 7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____
 Claim(s) objected to: _____
 Claim(s) rejected: _____
 Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
 9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
 10. ☐ Other: _____

Cynthia Keely

Continuation of 2. NOTE: the addition of the concentration of ionic chlorine of 100 ppm or less is a new limitation requiring a further search as previous limitations were not presented previously.

Continuation of 5. does NOT place the application in condition for allowance because: The 102b and 103 rejections are maintained for reasons of record. Applicant argues Nakajima does not teach or suggest the invention due to the ink concentration. The Applicant has not persuasively argued because Nakajima provides the same functionality as the same structure is provided by Nakajima. See col. 1 lines 35-45, col. 6, lines 1-23, col. 7, lines 1-15, and col. 10, lines 15-60 providing for the ink over the image-receiving layer. Allegations that a barrier is not present, is not believed because adhesive layer serves as the same functionality, as previously set forth. Allegations toward Hida not teaching a barrier layer that shields a circuit part from ink is not believed because Hida provides several types of barriers, such as reinforcing member 5 or 8, to teach a barrier functionality. The Applicant has not persuasively argued.